

REMARKS

The Office Action mailed June 25, 2008, has been received and reviewed. Claims 1-25 are currently pending in the application. Claim 23 was allowed. Claims 1-22, 24 and 25 stand rejected. Applicant has amended claim 25 and respectfully requests reconsideration of the application as amended herein. No new matter has been added.

35 U.S.C. § 112 First Paragraph, Written Description Rejection

Claim 25 stands rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant respectfully traverses this rejection, as hereinafter set forth.

The Office Action states:

The claim is directed to a computer readable media; however the examiner was not able to find support for this limitation in the specification. Please remember that the specification have to specify a computer readable media, a mention of an abstract software program will not suffice. (Office Action, pp. 2-3; emphasis added).

Applicant respectfully disagrees that claim 25 added in the previous amendment does not comply with the written description requirement of 35 U.S.C. § 112, first paragraph.

M.P.E.P. § 2173.05(c) provides:

There is no requirement that the words in [a] claim must match those used in [a] specification disclosure. Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision.

Furthermore, in *Staehelin v. Secher*, the Board held that “[s]atisfaction of the ‘written description’ requirement does not require an *haec verba* antecedence in the originally filed application.” (24 USPQ2d 1513, 1519 (B.P.A.I. 1992)). In *Ex parte Parks*, the Board further elaborated:

Adequate description under the first paragraph of 35 U.S.C. § 112 does not require *literal*

support for the claimed invention. . . . Rather, it is sufficient if the [] disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed. (30 USPQ2d 1234, 1236 (B.P.A.I. 1994).

Applicant respectfully directs the Examiner's attention to several passages within Applicant's application as originally filed, which provide an adequate basis for the language in question. Specifically, Applicant's as-filed specification includes the following passages in support of the exemplary claim languages of "***A computer-readable media having computer-executable instructions encoded thereon*** for performing a method for" Specifically, Applicant's as-filed specification recites, *inter alia*:

[1046] The ***steps of a method*** or algorithm described in connection with the embodiments disclosed herein ***may be embodied*** directly in hardware, ***in a software module executed by a processor***, or in a combination. ***A software module may reside in*** RAM memory, flash memory, ROM memory, EPROM memory, EEPROM memory, registers, hard disk, a removable disk, a CD-ROM, or ***any other form of storage medium*** known in the art. ***An exemplary storage medium is coupled to the processor such that the processor can read information from, and write information to, the storage medium.*** (Emphasis added.)

From Applicant's written description in Applicant's as-filed patent application, it is apparent that Applicant, at the time of invention, was in possession of the exemplary concept of "***A computer-readable media having computer-executable instructions encoded thereon***" as illustrated by the various claim language at issue.

Accordingly, Applicant respectfully submits that claim 25 complies with the written description requirement of 35 U.S.C. § 112, first paragraph, and requests that the 35 U.S.C. § 112, first paragraph, rejection of this claim be withdrawn.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on NPL XP-001017264, EP 0658014 and U.S. Patent No. 6,735,446

Claims 1-4, 6-10, 12-16, 18-20, 24 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over NPL XP-001017264 to Siwko ("Siwko") in view of European Patent Applicant No. EP 0658014 to Redden *et al.* ("Redden") and further in view of U.S. Patent No.

6,735,446 to Iwata *et al.* ("Iwata").

To establish a *prima facie* case of obviousness ***the prior art reference (or references when combined) must teach or suggest all the claim limitations.*** *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be "a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicants' disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

Furthermore, it "is improper to combine references where the references teach away from their combination." M.P.E.P. §2145(X)(D)(2) (citing *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983)). Similarly, ***if a "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification."*** M.P.E.P. §2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)).

The 35 U.S.C. § 103(a) obviousness rejections of claims 1-4, 6-10, 12-16, 18-20, 24 and 25 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or suggest all the claims limitations.

Regarding independent claim 1 and claims 2-4, 6 and 7 depending therefrom, independent claim 8 and claims 9, 10, 12 and 13 depending therefrom, independent claim 14 and claims 15, 16 and 18 depending therefrom, independent claim 19 and claim 20 depending therefrom and independent claims 24 and 25, Applicant's independent claims 1, 8, 14, 19, 24 and 25 include claim limitations not taught or suggested in the cited references.

Generally, Applicant's invention recites "receiving" and "adjusting" "an initial call request block probability" occurring **all at the same entity**, namely at the "mobile station/apparatus". Specifically, Applicant's independent claims 1, 8, 14, 19, 24 and 25 each recite, *inter alia*, "receiving at a mobile station/an apparatus an initial call request block probability ...and adjusting at the mobile station/the apparatus said initial call request block probability based on said elapsed time".

In contrast, neither Siwko nor Redden nor Iwata teach or suggest giving *adjustment* control to a mobile station. Generally, Siwko teaches of mobile stations freely generating unrestrained call requests and then the network access controller chooses which ones to admit or reject. Specifically, the Office Action states:

Siwko discloses that the receiving and adjusting occur at network element [note that *network element can be any element connected to the network, including the mobile device*] (Office Action, p. 4; emphasis added).

Siwko teaches no such thing. Specifically, Siwko does not teach that Siwko's "station" (*e.g.*, mobile device) is part of the "network". In fact, Siwko is very clear that Siwko's "station" (*e.g.*, mobile device) requests service (*e.g.*, access) of the network. The actual teachings of Siwko recite:

[S]tations desiring to use the network must first submit a connection request to the network access controller. These connection requests may be accepted or rejected. (Siwko, Section II, para. 1, lines 3-6; emphasis added).

Furthermore, Siwko teaches:

Connection *requests [from the mobile station] arrive at the system* ... [and] [a] CAC policy decides whether a connection request is to be admitted or rejected. Connections whose requests are rejected by the CAC policy are said to be blocked and are lost. (Siwko, Section II, para. 3, lines 4-8; emphasis added).

Clearly, Siwko's "station" (*e.g.*, mobile device) is defined as being separate from Siwko's "network" and not as alleged in the Office Action.

The Office Action then goes on to allege that Siwko is not clear which elements are performing which functions. Specifically, the Office Action alleges:

Siwko ... is silent regarding at *which element is doing those task[s]*. (Office Action, p. 4; emphasis added).

Applicant respectfully disagrees. Siwko is absolutely clear about which elements are performing which tasks. Specifically and again, Siwko discloses:

[S]tations desiring to use the network must first submit a connection request to the network access controller. These connection requests may be accepted or rejected. Each connection request accepted by the [network access] controller results in the allocation of some network resources to service the newly made connection. (Siwko, Section II, para. 1, lines 3-8; emphasis added).

Clearly and unequivocally, Siwko teaches a “station” (e.g., mobile device) makes a request to the network and the network accepts or rejects the request. Accordingly, the Office Action’s allegation that “Siwko ... is silent regarding at *which element is doing those task*” is unfounded and entirely inaccurate. (Office Action, p. 4; emphasis added).

Therefore, according to Siwko, all of the “receiving” and “adjusting” occur at the network and **not** at the “the mobile station/the apparatus” as claimed by Applicant. Accordingly, the rejection is improper and must be withdrawn since the Office Action has improperly characterized the teachings of Siwko.

Regarding Redden, the Office Action states:

Redden discloses *receiving at a mobile station and an initial call request block probability* (Office Action, p. 4; emphasis added).

Furthermore, Redden teaches:

FIG. 9 illustrates procedure 300 *performed by* a communication node (for example, *satellite* 12 of FIG. 1) ..., the communication node [e.g., satellite] receives a parameter set from the communication system ... task 304 [performed in the satellite] modifies the parameter set ... [task 314 [satellite] broadcasts the parameter set on at least one of the broadcast channels (Redden, p. 14, lines 4-19; emphasis added).

According to Redden, all of the “receiving” happens at either the satellite or at the mobile stations **after** the modifications have occurred while **all** of the “adjusting” happens either in the “communication node (e.g., satellite)” or the “communication system”. Accordingly, Redden also fails to teach of any “adjusting” occurring in the “the mobile station/the apparatus” as claimed by Applicant.

The Office Action introduces Iwata and states:

Iwata discloses a mobile device that receives a broadcast message that permits or inhibits the mobile device to transmit and adjust accordingly (see col. 13, line 49-col. 14, line 40). Therefore, it would have been *obvious* to one of the ordinary skills in the art at the time of the invention *to combine these teachings* to let the mobile station know when it is possible to transmit and make a call, without the need of the mobile station transmit when the wireless resources are not present, thereby efficiently managing the finite wireless resources. (Office Action, pp. 4-5; emphasis added).

Applicant respectfully disagrees. Applicant respectfully reminds the Examiner that if a “proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” M.P.E.P. §2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)).

Applicant respectfully points out that Siwko is intended to have a “station” (e.g., mobile device) making a request to the network and the network accepting or rejecting the request. The proposed modifications from Iwata of a broadcast message sent to a mobile device that “permits or inhibits the mobile device to transmit and adjust accordingly” (Office Action, p. 4) would destroy the intended purpose of Siwko in having the network receive requests from mobile stations and then admit or reject based upon the network’s knowledge of the available connection resources (Siwko, Section II, para. 3, lines 4-8). Therefore, *the Office Action’s proposed modification of Siwko by Iwata results in Siwko being destroyed for its intended purpose* of decision intelligence being retained at the network and mobile stations being controlled by the network. Therefore, there can be no motivation for such a proposed combination. Accordingly, the rejection is improper and must be withdrawn.

Therefore, since Siwko, Redden and Iwata, either individually or in any proper combination do not teach or suggest all of Applicant’s claim elements and furthermore since there can be no motivation to combine these references when the reference’s intended purpose is destroyed, these references cannot render obvious, under 35 U.S.C. §103, Applicant’s invention as presently claimed in Applicant’s independent claims 1, 8, 14, 19, 24 and 25 which each recite, *inter alia*, “receiving at a mobile station/an apparatus an initial call request block probability ...and adjusting at the mobile station/the apparatus said initial call request block probability

based on said elapsed time”. Accordingly, Applicant respectfully requests the rejection of independent claims 1, 8, 14, 19, 24 and 25 be withdrawn.

The nonobviousness of independent claims 1, 8, 14 and 19 preclude rejection of claims 2-4, 6, 7, 9, 10, 12, 13, 15, 16, 18 and 20 which variously depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claims 1, 8, 14 and 19 and claims 2-4, 6, 7, 9, 10, 12, 13, 15, 16, 18 and 20 which variously depend therefrom.

Obviousness Rejection Based on Siwko, Redden, Iwata and U.S. Patent No. 4,493,102

Claims 5, 11 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Siwko in view of Redden and Iwata and further in view of U.S. Patent No. 4,493,102 to Weishaup (“Weishaup”).

The nonobviousness of independent claims 1, 8 and 14 preclude rejection of claims 5, 11 and 17 which respectively depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claims 1, 8 and 14 and claims 5, 11 and 17 which respectively depend therefrom.

Obviousness Rejection Based on Redden, Siwko and Iwata

Claims 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Redden in view of Siwko and further in view of Iwata.

To establish a *prima facie* case of obviousness ***the prior art reference (or references when combined) must teach or suggest all the claim limitations***. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be “a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705,

75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicants' disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

Furthermore, it "is improper to combine references where the references teach away from their combination." M.P.E.P. §2145(X)(D)(2) (citing *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983)). Similarly, *if a "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification."* M.P.E.P. §2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)).

The 35 U.S.C. § 103(a) obviousness rejections of claims 21 and 22 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or suggest all the claims limitations. Regarding independent claim 21 and claim 22 depending therefrom, Applicant's independent claim 21 includes claim limitations not taught or suggested in the cited references.

Generally, Applicant's invention recites "determining" and "adjusting" "an initial call request block probability" all at the same entity, namely at the "apparatus". Specifically, Applicant's independent claim 21 recites, *inter alia*, "determining at the mobile station an elapsed time from an effective time of said initial call request block probability, wherein the block probability is determined by a network element and adjusting at the mobile station said initial call request block probability based on said elapsed time".

Applicant herein sustains the above-proffered arguments that Redden, Siwko and Iwata, either individually or in any proper combination, do not teach or suggest all of Applicant's claim elements and therefore cannot render Applicant's claimed invention obvious under 35 U.S.C. § 103. Accordingly, the rejection of claim 21 must be withdrawn.

Additionally, Applicant respectfully reminds the Examiner that if a “proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” M.P.E.P. §2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)).

Again, Applicant respectfully points out that Siwko is intended to have a “station” (e.g., mobile device) making a request to the network and the network accepting or rejecting the request. The proposed modifications from Iwata of a broadcast message sent to a mobile device that “permits or inhibits the mobile device to transmit and adjust accordingly” (Office Action, pp. 7-8) would destroy the intended purpose of Siwko in having the network receive requests from mobile stations and then admit or reject based upon the network’s knowledge of the available connection resources (Siwko, Section II, para. 3, lines 4-8). Therefore, *the Office Action’s proposed modification of Siwko by Iwata results in Siwko being destroyed for its intended purpose* of decision intelligence being retained at the network and mobile stations being controlled by the network. Therefore, there can be no motivation for such a proposed combination. Accordingly, the rejection is improper and must be withdrawn.

Therefore, since Redden, Siwko and Iwata, either individually or in any proper combination do not teach or suggest all of Applicant’s claim elements and furthermore since there can be no motivation to combine these references when the reference’s intended purpose is destroyed, these references **cannot** render obvious, under 35 U.S.C. §103, Applicant’s invention as presently claimed in Applicant’s independent claim 21 which each recites, *inter alia*, “determining at the mobile station an elapsed time from an effective time of said initial call request block probability, wherein the block probability is determined by a network element and adjusting at the mobile station said initial call request block probability based on said elapsed time”. Accordingly, Applicant respectfully requests the rejection of independent claim 21 be withdrawn.

The nonobviousness of independent claim 21 precludes rejection of claim 22 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. §

103(a) obviousness rejection to independent claim 21 and claim 22 which depends therefrom.

Allowable Subject Matter

Claim 23 is allowable.

Applicant acknowledges this indication with appreciation

CONCLUSION

Claims 1-25 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicant's undersigned representative.

Respectfully submitted,

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